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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/801,234	03/16/2004	Fu-Hsin Chen	24061.79	2028
42717	7590	12/02/2005	EXAMINER	
HAYNES AND BOONE, LLP 901 MAIN STREET, SUITE 3100 DALLAS, TX 75202			DICKEY, THOMAS L	
			ART UNIT	PAPER NUMBER
			2826	

DATE MAILED: 12/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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# **Advisory Action Before the Filing of an Appeal Brief**

**Application No.**

10/801,234

**Applicant(s)**

CHEN ET AL.

**Examiner**

Thomas L. Dickey

**Art Unit**

2826

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 21 November 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## **NOTICE OF APPEAL**

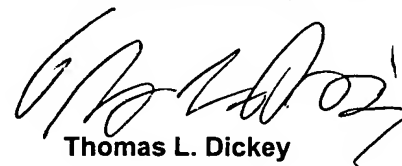
2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

## **AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: 10, 11, 26 and 27.  
Claim(s) rejected: 8, 9, 24, 25 and 28.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

  
**Thomas L. Dickey**  
**Patent Examiner**  
**Art Unit 2826**

## **AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal, will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

## **REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

Continuation of 3. NOTE: applicant's amendment cancels withdrawn claims 1-7 and 12-16 but makes no other changes. For this reason it simplifies issues for appeal.

Continuation of 11. does NOT place the application in condition for allowance because: It is argued, at page 5 of the remarks, that "Applicant agrees that the Federal Circuit is holding that 'substantially' is used to 'avoid a strict numerical boundary to the specified parameter.'" From this it appears that Applicant and Examiner are in substantial agreement that the term "substantial" is a meaningful modifier implying "approximate," rather than "perfect."

It is argued, at page 6 of the remarks, that "The statements made in the Office action regarding [the Federal Circuit's Playtex decision] simply do not provide support for the Office action's contention that a difference of 30% is 'substantially equal'." However, the question of what a particular piece of prior art (in this case HOSHINO ET AL. 2001/0012671) does or does not disclose is a question of fact and therefore the responsibility of the Patent Office, not the Federal Circuit. Furthermore, the meaning of "substantially equal" depends on the factual issue of which items are claimed to be substantially equal (the phrase "near miss," for example, takes on a different meaning depending whether the art is darts or artillery). Anticipation is a factual issue. How to determine anticipation is a legal issue for the Federal Circuit, but the ultimate factual issue remains with the Office.

It is argued, at page 6 of the remarks, that "In addition, the Office action states on page 8 that 'when comparing resistances (which often vary by orders of magnitude), 2.75 ... is in fact substantially equal" to 2.1.' However, the 2.75 and 2.1 refer to slopes, and Applicant submits that a variation of approximately 30% for a slope is simply not substantially equal."

Applicant's statement "2.75 and 2.1 refer to slopes" is misleading. 2.1 and 2.75 are merely the slopes of lines drawn on pieces of paper. They reflect the fact that in 12 data points measured in 2 separate experiments, Hoshino and his colleagues found that their disclosed device measured an average change of about 2.75 Ohms per micron change in channel length, and an average change of about 2.1 Ohms per micron change in offset (lightly-doped drain extension) length. The piece of paper with the slope drawn on it does not anticipate applicant's claimed invention. It is the device described on the piece of paper that does so. According to said description the device has a channel region formed in a substrate between its first drain region and source region with a resistance per unit length (2.75 ohms per micron) that is substantially (given that we are comparing the resistances associated with given lengths) equal to a resistance per unit length (2.1 ohms per micron) of a first drain region (the "offset region," as Hoshino calls the lightly doped drain extension).